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EXAMINER KIM, JENNIFER M				
ART UNIT		PAPER NUMBER		
1628				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

09/367,950

Applicant(s)

EKSTROM, TOMMY

Examiner

JENNIFER M. KIM

Art Unit

1628

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-36, 38 and 42-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-36, 38 and 42-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 3/8/2010/12/21/2009

DETAILED ACTION

The amendment filed December 21, 2009 have been received and entered into the application.

Response to Arguments

Applicant's arguments filed December 21, 2009 have been fully considered but they are not persuasive. With regard to 35 USC § 101 rejection, Applicant argues that the present claims require two steps: (1) providing an inhaler to the patient, and (2) providing a recommendation to the patient regarding use of the inhaler and that the Board's remand did not address a claim with those two steps, so could not possibly support the Examiner's conclusory assumption that the present claims do not involve a "transformation". This is not found to be persuasive because the recited steps still do not change the meaning of the term "as needed" described by Applicants encompasses not only the medical "need" determined by the patient but reads on the circumstances where there is **no** "need" of administration of the claimed composition. It is noted that the claim 13 only requires that the patient be instructed to do something (e.g. inhale a composition) on demand and providing a recommendation. There is no requirement that the patient actually inhale the composition (see also oral hearing transcript 7:11-19). Therefore, what happens after the patient is recommended to inhale the composition is not an element of the claim. There is no requirement a practical application actually be associated with the "recommendation" and "providing an inhaler".

"[a] process is ... an act, or a series of acts, performed upon the subject matter to be *transformed and reduced* to a different state or thing." In re Schrader, 22 F.3d 290, 293-94, 30 USPQ2d 1455, 1459 (Fed. Cir. 1994), citation omitted. (See also State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998) holding that a claimed system was statutory subject matter because it produced "a useful, concrete and tangible result."). In this case, neither a transformation nor reduction would result from the claimed invention because the limitation that the patient actually performs the administration of the claimed composition is not an element of the claim. Again, a recommendation for action and providing an inhaler do not guarantee that the required step be taken which would achieve the "reduction" or "transformation" in the process claims because there is no requirement that the patient actually inhale the composition (see oral hearing transcript 7:11-19).

With regard to 35 U.S.C. 103 rejection, Applicant argues that Applicant has previously pointed out that Carling says the combination should be administered just twice per day (BID) and that the Examiner has acknowledged. The examiner is in agreement with Carling's teaching of BID dosing, however, the Examiner has also pointed out previously that Carling et al. on pages 7-9 exemplify amounts of active agents per dose of inhalation, which calculate up to 8 inhalation per day without going over the maximum daily dosage in the treatment of asthma. Therefore, one of ordinary skill in the art would immediately recognized that a patient experiencing acute asthmatic attack even with ongoing twice a day dosing regimen, he still can safely inhale

additional 6 inhalations without going over the maximum suitable daily dosage in general asthmatic condition taught by Carling et al. to achieve its known therapeutic relief from asthmatic attack. The skilled artisan would have been motivated to recommend that those patients, currently using the specific Carling et al combination of formoterol and budesonide for maintenance therapy, use the combination during an asthmatic attack at a dose up to the limit recommended by Carling et al for such an emergency. One of ordinary skill would recognize that it is advantageous for the patient to self-administer the treatment to avoid the dire consequences of waiting for professional assistance. Applicant argues that that Applicant has previously explained that the teaching in Carling about varying the dosage according to the "severity of disease" means that the physician should set a dosage (always to be administered twice per day) based on the patient's severity of disease, certainly not that the patient is free to do so. This is not persuasive because again, Carling teaches the safe and effective daily dosage of the combination, which calculates up to 8 inhalation per day (page 7-9 examples). Therefore, it would be obvious to one of ordinary skill in the art to recommend to the patient in need of treating/preventing asthmatic attack to self-administer the treatment up to the safe and effective daily amounts to avoid the dire consequences of waiting for professional assistance in the emergency situations. Applicant argues that the Symbicort® Turbohaler® should be administered twice per day unless the patient's doctor has decided that administration just once per day is sufficient to control the patient's symptoms. To this response, it is the Examiner's position that safe and effective dosage of the combination for the treatment of asthma is

already and known in view of Carling et al. Therefore, the instructing to self-medicate at the time of exacerbation of unexpected asthmatic attack when needed as determined by the patient with out going over the daily safe and effective amounts taught by Carling have been obvious to a person having ordinary skill in the art, in particular the attending clinician. Accordingly, one of ordinary skill in the art would take account of the inferences and creative instructions that a person of ordinary skill in the art would provide such instructions and recommend patients to self-administer in an event of emergency within the limits of the known safe and effective daily amounts and a dosing frequency taught by Carling. (*KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). See also *id.* at 1742 ("A person of ordinary skill is also a person of ordinary creativity, not an automation.")). Thus, the claims fail to patentably distinguish over the state of the art as represented by the cited references.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-36, 38, 42 and 43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 13, 42 and 43 require steps to "providing" a patient as inhaler and "provide" a recommendation to use the inhaler .."if" or "when" the patient experiences acute asthma symptoms. It is noted that a process is an act or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing. Therefore, what happens after the providing steps, the actual administration of the inhaler to patient's body is not an element of the claim. There is no requirement a practical application actually be associated with this provided steps. "[a] process is ... an act, or a series of acts, performed upon the subject matter to be *transformed and reduced* to a different state or thing." In re Schrader, 22 F.3d 290, 293-94, 30 USPQ2d 1455, 1459 (Fed. Cir. 1994), citation omitted. (See also State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998) holding that a claimed system was statutory subject matter because it produced "a useful, concrete and tangible result."). In this case, neither a transformation nor reduction would result from the claimed invention because the limitation that the patient actually performs the administration of the claimed composition is not an element of the claim. The "reduction" or "transformation" would only occur with the actual administration of the claimed combination. Claim 13 only requires that the patient be instructed to do something (e.g. inhale a composition) on demand when the patient experiences an increase in asthma symptoms. There is no requirement that the patient actually inhale the composition (see Oral Hearing Transcript 7:11-19). Thus, no reduction or transformation would take place with the claimed invention because the claims do not recite the necessary step of a practical

application associated with the claimed recommendation. That is, a recommendation for action does not guarantee that the required step be taken which would achieve the claimed "reduction" or "transformation". Therefore, the claimed subject matter is deemed non-statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-36, 38 and 42-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims are drawn to a method of **prevention and/or treatment** of a patient's asthma symptoms, the method comprising (i) **providing an inhaler** to the patient, the inhaler containing a composition comprising, in admixture; (a) a first active ingredient which is formoterol, a pharmaceutically acceptable salt or solvate thereof or a solvate of such a salt; and (b) a second active ingredient which is budesonide; and (ii) **providing a recommendation** to the patient to inhale the composition from the inhaler on an as-needed basis, as determined by the patient based on the patient's symptoms, as a treatment and a preventive measure, when the patient experiences an increase in asthma symptoms. Therefore, the claims require (i) providing an inhaler to the patient and (ii) providing a recommendation to the patient. It is noted that the claim 13 only

requires that the patient be instructed to do something (e.g. inhale a composition) on demand and providing a recommendation. There is no requirement that the patient actually inhale the composition (see also oral hearing transcript 7:11-19). Therefore, it is not clear how the prevention and/or treatment of asthma is accomplished by providing an inhaler and a recommendation without the actual step of administration of the inhaler containing the active agents to treat/prevent asthma.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 13-15, 17, 18, 20-36, 38 and 42-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carling of record.

Carling et al. on page 6, lines 5-30, teach the suitable daily asthmatic dose of formoterol fumarate dihydrate as required by claim 15 and budesonide within Applicant's daily dosage of "on demand" (twice a day) and the dosages strongly depends on the patient (age, weight etc.), severity of disease (mild, moderate, severe asthma etc..).

Carling et al. on pages 7-9 exemplify amounts of active agents per dose of inhalation, which calculate up to 8 inhalation per day without going over the maximum daily dosage.

Carling teaches at page 8-14, page 3, line 35 through page 4, line 10, lines 30-35, page 6, lines 5-30, and page 7, lines 1-5, teach a composition comprising Applicant's active agents use for treating respiratory disorder such as asthma set forth in claims 13-15, 17-18, 20-21, and 23.

Carling et al. at page 4, lines 3-10, also teach that the combination of formoterol and budesonide has not only a greater efficiency and duration of bronchodilator action but also a rapid onset of action.

The difference between Carling et al. and Applicant's invention is recommending a patient to use the inhaler as needed and when needed as determined by the patient based on the patient's symptoms, to provide short-term symptomatic relief of acute asthmatic symptoms set forth in claims 13 and 36, instructing patient to inhale additional doses as needed if he experiences asthma including acute asthmatic episode, a specific carrier set forth in claim 24, the molar ratio of active agents set forth in claim 14, and the particle size set forth in claim 22 and recommendation resulting at least one use of the inhaler set forth in claims 49-53.

However, to recommend the patient to inhale, as needed, as determined by the patient's symptoms to treat and/or prevent acute asthmatic episode is obvious since Carling et al. teach that the effective dosages strongly depends on the severity of disease (mild, moderate, severe asthma) being treated and the suitable daily dosage is

up to 8 inhalation. One of ordinary skill in the art would be motivated to recommend those asthmatic patients depend on the severity of condition such as mild, moderate, severe, to use the Carling's composition as needed bases up to 8 inhalations as suggested by Carling et al. in order to optimize the dosages and prevent further flare up depending on the severity of asthmatic conditions that each of the patients disclosed by Carlings. One of ordinary skill in the art would make such a modification in order to achieve maximum benefits of effective and safe daily dosages recommended by Carling et al. It is noted that combination of formoterol with budesonide is well known to be beneficial for the treatment of asthma as taught by Carling et al. Moreover, if that patient experiencing acute asthmatic attack even with ongoing twice a day dosing regimen, he still can safely inhale additional 6 inhalations without going over the maximum suitable daily dosage in general asthmatic condition taught by Carling et al. to achieve its known therapeutic relief from asthmatic attack. The skilled artisan would have been motivated to recommend that those patients, currently using the specific Carling et al combination of formoterol and budesonide for maintenance therapy, use the combination during an asthmatic attack at a dose up to the limit recommended by Carling et al for such an emergency. One of ordinary skill would recognize that it is advantageous for the patient to self-administer the treatment to avoid the dire consequences of waiting for professional assistance.

Further, patients disclosed by Carlings including those taking twice a day regimen (at least one occasion), e.g. two-times per day to prevent and treat asthma

symptoms would be included in the range of "as needed as determined by the patient" because those patients may only "need" twice a day dosing per their medical condition.

The molar ratio of active agents to be used set forth in claim 14, the selection of carrier set forth in claims 23 and 24, and the particle size of active agents set forth in claim 22, are all deemed obvious since they are all within the knowledge of the skilled pharmacologist and represent conventional formulations.

Claim 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carling et al. of record as applied to claims 13-15, 17, 18, 20-36, 38, 42-50 above, and further in view of Aberg et al. (U.S. Patent 5,795,564) and Ryrfeldt et al. of record.

Carling et al. as applied as before.

Carling et al. do teach the isomer of formoterol set forth in claim 16 and the specified epimer of budesonide set forth in claim 19.

Aberg et al. teach (R, R) isomer of formoterol as required by claim 16 is a potent bronchodilator with reduced adverse effects in treatment of asthma. (abstract, column, 1, lines 25-35).

Ryrfeldt et al. teach that 22R epimer of budesonide is more potent in the treatment of bronchial asthma than 22S epimer.

However, it would have been obvious to one of ordinary skill in the art to employ (R, R) enantiomer of formoterol and 22 R epimer of budesonide in view of Aberg et al. and Ryrfeldt et al. because both of the references of Aberg and Ryrfeldt teach specific isomers form that possesses potent asthmatic effect of the active agents utilized in Carling reduced adverse effects in treatment of asthma. One would have been

motivated to employ (R,R) isomer of formoterol and 22R epimer of budesonide in Carling's composition with reasonable expectation of successfully treating asthmatic patients with reduced adverse effects.

For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 103.0

None of the claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Communications

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER M. KIM whose telephone number is (571)272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JENNIFER M KIM/
Primary Examiner, Art Unit 1628

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March 11, 2010